

**REMARKS**

Claims 1 to 15 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is therefore respectfully requested.

With respect to paragraph three (3) of the Office Action, claims 1 to 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Cotton et al., U.S. Patent No. 4,640,110, in view of Herzog et al., U.S. patent No. 4,703,356.

*It is respectfully submitted that even if there were some motivation to apply "Herzog" to the primary reference of "Cotton" (which is not conceded), a person having ordinary skill in the art would still not obtain the claimed subject matter. This is because even if it were taken into account that the manual recording of images of "Herzog" could be done when an alarm occurs according to "Cotton", the person having ordinary skill in the art may (for the purposes of this discussion) arrive at the solution that a sequence is recorded and that according to "Herzog", the sequence is repeated after a play loop is depressed. However, there is no suggestion that a sequence is displayed upon occurrence of the event, as asserted in the Final Office Action.*

Thus, claim 1 is to an observation system having an observation monitor unit, which includes means for recording a plurality of images including an image at a time of the event, and means for repeatedly displaying a sequence formed by the plurality of images upon the occurrence of the event.

The Office Actions to date assert that the Herzog reference "teach[es] means for repeatedly displaying the sequence formed of [a] plurality of images" and further asserts that it would have been obvious for one of ordinary skill in the art to incorporate the display means of Herzog into the observation system of Cotton for the purpose of repeatedly displaying the sequence of images. It is submitted that the asserted motivation to combine the primary Cotton reference with the secondary Herzog references lacks adequate foundation as to the legal standards discussed below.

In the method referred to in the secondary Herzog reference, a recording loop begins *by the manual operation of a button*. (See Herzog, col. 4, lines 32 to 47). The recording fills the available memory space and may be repetitively replayed by manually pressing another "play loop" button. (See Herzog, col. 5, lines 12 to 24). What is missing here is any evidence as to how this manual frame repetition method in any way suggests repeatedly

displaying a sequence formed by the plurality of images upon the occurrence of the event as provided for in the context of claim 1. Even there were some motivation for the skilled practitioner to apply the purported disclosures of Herzog reference to those of the primary Cotton reference – which is not admitted – the manual repeat loop of Herzog does not lend itself to the event based repetition claimed because the Herzog process merely prescribes continuously filling an available memory space with video information upon the pressing of a button (and then making this video data available for repetitive display) without regard to the usefulness of recording a particular frame, whereas the Cotton reference discloses recording a limited amount of video information upon the activation of an alarm. In fact, Cotton specifically explains that:

By using the timed relationship between switch closures, and the sequential relationship between switch closures to define alarm events, activities of employees which are unacceptable will be monitored and recorded, without recording an undue number of normal transactions.

(See Cotton, col. 6, lines 12 to 17)(emphasis added).

In light of the incompatible elements of the processes described in the primary Cotton and secondary Herzog references, a person having ordinary skill would not be motivated to combine the references to provide the presently claimed subject matter and its benefits, as explained in the specification.

Accordingly, claim 1 is allowable.

Regarding claims 2 to 4, 7, 10 and 13, which depend from claim 1, it is respectfully submitted that these claims are allowable for at least the same reasons as claim 1.

Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

Claims 8, 11 and 14 depend from claim 5 and are therefore allowable for the same reasons as claim 5.

Claims 9, 12 and 15 depend from claim 6 and are therefore allowable for the same reasons as claim 6.

With respect to paragraph two (2), claims 1 to 3, 5 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tapp, U.S. Patent No. 5,657,076 in view of the British patent document to Quirk, GB 2 203 586.

*In short, it is respectfully submitted that the secondary “Quirk” reference does not cure the critical deficiencies of the “Tapp” reference. This is because “Quirk” repeats the images spatially on several displays and therefore shows the same image on several displays at the same time.*

In particular, regarding the primary Tapp reference, the Office Action admits that it does not disclose repeatedly displaying a sequence as recited in claim 1. The Quirk reference simply does not cure the critical deficiencies of the Tapp reference. The “repeated images” referred to in the Abstract of the Quirk reference are repeated ***spatially and not temporally*** as is clearly stated on page 1, lines 23 to 26 which indicate that the purported electronic screens “may form a repeated image or the individual images may form a mosaic of a larger image.” (emphasis added). It is clear from the specification of the present application that the claimed repeated display occurs over time, and it is therefore submitted that the combined Tapp and Quirk references do not disclose or suggest all of the features of claim 1, which is therefore allowable over the references relied upon.

Claims 2 and 3 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

With respect to paragraph three (3), claims 1 to 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tapp in view of Johnson, U.S. Patent No. 6,175,373.

*The “Johnson” reference addresses an entirely different problem, so that a person having ordinary skill in the art would not have any motivation to combine “Tapp” and “Johnson”. Even if combined, a person having ordinary skill in the art would not obtain the claimed subject matter because the secondary “Johnson” reference does not cure the critical deficiencies of the primary “Tapp” reference. In particular, the “Johnson” reference does not disclose or suggest the feature of repeatedly displaying a sequence. Instead, the “Johnson” reference refers to displaying each buffer only once and not repeatedly (see Figures 4a and 4b). Also, the graphic refresh of “Johnson” is not performed upon the occurrence of an event.*

Also, regarding the primary Tapp reference, as explained above, the Office Action admits that it does not disclose the feature of repeatedly displaying a sequence as provided for in the context of claim 1.

The Office Actions to date admit that the primary reference does not repeatedly display a sequence as provided for in the context of the claim. The secondary Johnson reference does not cure this critical deficiency since even if it were proper to combine the reference (which it is not), the “graphics refresh” feature purportedly described in the Johnson reference is not performed upon the occurrence of the event as is the repetition of the display as in claim 1.

Still further, the secondary reference does not concern security systems, and is only directed to providing buffers for a video system, in which only one of the video data portions in the buffer is selectively displayed to provide non-genlocked (non-synchronized) live video on a computer system. Thus, the secondary reference is directed to addressing an entirely different problem than is addressed by the presently claimed subject matter in which a sequence formed by a plurality of images is displayed upon occurrence of the event. Put another way, the primary Tapp reference does not disclose using a repetition of images pertinent to a security-threatening event (such as, for example, images of the pertinent location from before and after an event) to cause alarm and promote security. The Johnson reference similarly does not disclose or suggest repeating images pertinent to a security-threatening event to cause alarm and promote security. Accordingly, the combination of Tapp and Johnson does not disclose or suggest this important aspect of the claimed subject matter.

Accordingly, claim 1 is allowable.

Claims 2 to 4, 7, 10 and 13 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

Claims 8, 11 and 14 depend from claim 5 and are therefore allowable for the same reasons as claim 5.

Claims 9, 12 and 15 depend from claim 6 and are therefore allowable for the same reasons as claim 6.

As further regards the references relied upon, it is respectfully submitted that they likewise do not describe or even suggest means for performing the recited functions discussed above. (See M.P.E.P. §§ 2181 to 2184). In particular, M.P.E.P. § 2182 specifically states that both before and after In re Donaldson Co., 16 F.3d 1189, 29

U.S.P.Q.2d 1845 (Fed. Cir. 1994), applying a reference to a means-plus-function limitation “requires that the [referenced] element perform the identical function specified in the claim.” As explained, the systems of the references relied upon do not perform the recited functions, as recited in the context of the claims.

In this regard it is noted that the Office Actions do not address the fact that even if any of the references relied upon did disclose the function of the means recited in the claims — which they do not as explained above, the Patent Office must meet its initial proof burden by showing that the referenced structure is the same as or equivalent to the structure described in the specification corresponding to the means as claimed. (See M.P.E.P. § 2182). It is believed and respectfully submitted that the referenced structure of the references relied upon is not the same as or equivalent to the structure described in the present application corresponding to the means as recited in the context of the claim. It is believed to be self-evident, for example, that the structures are not the same in view of the foregoing. In any event, the U.S.P.T.O. bears this proof burden, which has not been addressed in any way.

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998), which as referred to above simply do not address the problems met by the subject matter of any of the rejected claims.

In particular, the claimed subject matter is directed to solving the problem of having an observation system in which a detected relevant event is missed. This problem is solved by repeatedly displaying a sequence of images formed upon the occurrence of the detected event, including an image at the time of the event that occurs outside the observation system, so as to provide the benefit of drawing attention to the monitor. There is nothing in any of the references relied upon that in any way discloses or suggests how to solve the problem and/or provide the benefits resulting from the claimed subject matter.

U.S. Pat. App. Ser. No. 09/304,552  
Attorney Docket No. 10191/3248  
(formerly PHN 16.914)  
Reply to Final Office Action of December 21, 2004

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Actions' assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Office Actions to date reflect hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" — which is not even the case here, there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed", stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a

technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

Accordingly, claims 1 to 15 are allowable for all of the above reasons.

#### CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that currently pending claims 1 to 15 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

Dated: 6/15/2005

By: Richard L. Mayer

Richard L. Mayer  
(Reg. No. 22,490)

KENYON & KENYON  
One Broadway  
New York, New York 10004  
(212) 425-7200

CUSTOMER NO. 26646